| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/937,053 | 12/21/2001 | Ernst Schneider | 2345/164 | 4676 |

26646        7590        03/16/2004

KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

| EXAMINER |
|---|
| TAYLOR, BARRY W |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2643 | |

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *22 December 2003*.

2a)☒ This action is **FINAL**.          2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is. closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *18-32* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *18-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____ .

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1.      Claim 24-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.  The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.  For example, claim 24 recites, and a device for comparing the contents of a connection-related reference data record produced by the test unit to the contents of each communications data record of interrelated communications data records produced by the digital switch exchange with regards to a test communications connection.  The Examiner is unable to find support for this limitation in Applicant's original specification.

2.      Claim 29-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.  The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.  For example, claim 29 recites, generating a plurality of interrelated and connection-related communications data records in the digital switching exchange; recognizing interrelated communications data records which

are assigned to the test communications connection and comparing contents of the

connection-related reference data record to contents of each of the interrelated

communications data records. The Examiner is unable to find support for this limitation

in Applicant's original specification.

## Response to Amendment

3.      The amendment filed 12/22/03 is objected to under 35 U.S.C. 132 because it

introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment

shall introduce new matter into the disclosure of the invention. The added material

which is not supported by the original disclosure is as follows: Paper number 7, dated

12/22/03, under "MARKED UP VERSION OF THE SUBSTITUTE SPECIFICATION"

introduces new matter on page 1 lines 24-28; new matter also found on page 5 line 8

"or alternating between two lines"; new matter also introduced on page 8 lines 8-10

"Another device is used for recognizing interrelated communications data records which

are assigned to a test communication connecton".

Applicant is required to cancel the new matter in the reply to this Office Action.

## Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public
use or on sale in this country, more than one year prior to the date of application for patent in the United
States.

4.    Claims 18-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Chin

et al (5,729,588 hereinafter Chin).

Regarding claim 18.  Chin teaches a system for validating connection-related

communications data collected by a digital switching exchange (see Title, abstract),

comprising:

at least one test unit (see figure 1 wherein test unit 50), which can be linked to

the digital switch (see 30 figure 1), having a first memory unit for storing dedicated

communications elements (col. 2 lines 25-52, col. 3 line 8 – col. 4 line 28, col. 6 line 5 –

col. 7 line 62), a device for initiating the establishment of at least one dedicated test-

communications connection (see figure 1 wherein test unit 50 has a device 20 that

produces a test signal), a device for producing a connection-related reference data

record from the corresponding communications elements, from the starting and ending

instants of the test communications connection (see figures 2a-2b and figures 3a-3b

regarding automated message accounting features data, abstract, col. 1 lines 25-52,

col. 4 lines 29-34), a device for transmitting the connection-related communications

elements to the digital switching exchange (col. 4 lines 29-34);

the digital switching exchange (see 30 figure 1), which functions in response to

the received, connection-related communications elements to establish the relevant test

communications connection (see figure 1 wherein a device 40 responds to test signal);

a system evaluator (see 60 figure 1) assigned to the test unit (see test unit 50

figure 1) and to the digital switching exchange, including a device for comparing the

contents of the connection-related reference data record to the contents of each

connection-related communications data record belonging thereto (col. 2 lines 44-46,

col. 3 lines 25-28, col. 4 lines 2-8 and lines 40-56, col. 6 line 5 – col. 9 line 46),

wherein the digital switch exchange has a device for generating a plurality of

communications data records for respective test communications connection and the

system evaluator has a device for recognizing communications data records which are

assigned to any test communications connection, and a comparator compares each of

the communications data records that correspond to the respective reference data

record.  Chin further shows (see figure 1 wherein controller 70 used for converting into

predefined format and col. 2 lines 44-46, col. 3 lines 1-67, col. 4 line 2  – col. 9 line 46)

for converting the format of the reference data record into a predefined format and a

second device (see figure 1 wherein the digital switch 30 responds to test call by

converting into predefined format via 40 and col. 2 lines 44-46, col. 3 lines 1-67, col. 4

line 2  – col. 9 line 46) for converting the format of each communication data record into

the predefined format enabling for faulty data to be indicated (col. 7 lines 50-57, col. 8

lines 16-57).


Regarding claims 19-23.  Chin teaches wherein the system evaluator (see 60

figure 1), in addition, includes the following features:

A first device (see figure 1 wherein controller 70 used for converting into

predefined format and col. 2 lines 44-46, col. 3 lines 1-67, col. 4 line 2  – col. 9 line 46)

for converting the format of the reference data record into a predefined format and a

second device (see figure 1 wherein the digital switch 30 responds to test call by

converting into predefined format via 40 and col. 2 lines 44-46, col. 3 lines 1-67, col. 4

line 2 – col. 9 line 46) for converting the format of each communication data record into

the predefined format.


Regarding system claims 24-32. See 112 first rejection listed above and

amendment objected to under 35 U.S.C. 132 also listed above.


## *Conclusion*

5.      The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

     ---(5,539,802) De Caluwe et al discloses a system for testing the billing function

in a telecommunication system (i.e. "itemized billing") using start code signal (columns

1-2 and the most important instructions listed on column 4).

     ---(5,579,476) Cheng et al discloses an automated test environment that

"catches" data outputted from communication protocol software implemented in the

upper and lower communications protocol software (i.e. automatic interpretive test

system with a single tester, i.e. the lower and upper tester are combined into a single

tester). In other words using communications protocol software implementation under

test (a.k.a. "IUT") is tested by emulating the data and control message inputs which may

be received form higher and lower communications protocol software and if in response

to these inputs, the IUT outputs the correct data and control messages (i.e. as per the

protocol of the higher or lower layer), the IUT passes the test.

---(5,740,355) Watanabe et al teaches transaction tracing apparatus and also

cites Cheng (see Cheng listed directly above) wherein "multiple" pairs of send

information and returning information can be set fro a singular sequence information.

Thus, "conversion" between pluralities of systems can be extracted with a single

sequence filter.

---(5,835,566) Cowgill teaches system and method for testing component (i.e.

"UUT") having a programmable switch connected to the UUT through

telecommunications network via an in-band and out-of-band signaling path providing for

a system adaptable to allow for any variations in the operation and protocols that may

rise.

---(6,526,124) Swahn et al teaches method for testing an object in a

telecommunications system and cites Cowgill (see Cowgill listed directly above) wherein

a telecommunications system having incoming side and outgoing side is tested. Swahn

also uses common terms such as "IUT" and SUT (i.e. System Under Test) wherein SUT

is provided on the interface between two network providers as well as other common

terms such as PCOs (i.e. Points of Control and Observation) that are required for

testing. In other words, Points of Control and Observation are commonly used for

linking the system under test to signaling points.

## Response to Arguments

6.      Applicant's arguments filed 12/22/03 have been fully considered but they are not

persuasive.

        a) Regarding Applicant's remarks on page 7, last thirteen lines, wherein

Applicant's argue that the rejection under 35 U.S.C 102(b) is moot in light of the

cancellation of claims 1 to 17.  Moreover, Applicant's respectfully submit that the Chin

reference does not render anticipated new claims 18 to 32.

        The Examiner respectfully disagrees.  Claim 18 is a broader version of old claim

1, therefore is rejected for the same reason as old claim 1.  Regarding the remaining

independent claims (i.e. claims 24 and 29).  See Examiner's  112 first rejection and

amendment objected to under 35 U.S.C. 132 listed in sections 1 to 3 above.

        b) Applicant's continue to argue that Chin does not teach the new matter entered

independent claims 24 and 29 (see last paragraph on page 8 continuing to last page).

        The Examiner notes that Applicant's argue the new matter that has been entered

into the specification (see Examiner's  112 first rejection listed and amendment objected

to under 35 U.S.C. 132 also listed in sections 1 to 3 above.


7.      **THIS ACTION IS MADE FINAL.**  Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).


8.      A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action.  In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action.  In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Barry W. Taylor whose telephone number is (703) 305-

4811.  The examiner can normally be reached on Monday-Friday from 6:30am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Curtis  Kuntz can be reached on (703) 305-4708.  The fax phone number for

this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to Technology Center 2600 customer service Office

whose telephone number is (703) 306-0377.

CURTIS KUNTZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600